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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/663,776 | 09/17/2003 | Byung K. Yi | 2101-3239D1 | 2956 |

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| EXAMINER | |
|---|---|
| DIEP, NHON THANH | |

| ART UNIT | PAPER NUMBER |
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| 2621 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/663,776 | YI, BYUNG K. | |
| | Examiner | Art Unit | |
| | Nhon T. Diep | 2621 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *63-67,69-71 and 75-99* is/are pending in the application.

4a) Of the above claim(s) *63,69-71,80-89 and 98* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *75-79,90-97 and 99* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/2003; 3/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of group II (claims 75-79, 90-97 and 99 in the reply filed on 5/3/2007 is acknowledged. The traversal is on the ground(s) that group I and II share a technical feature of displaying stored images and are therein related. This is not found persuasive. The Examiner has carefully reviewed the applicants' arguments from the response filed December 4, 2006, but still maintains the restriction requirement for the following reasons. Groups I and II are not disclosed as capable of use together, and they have different modes of operation, different functions, or different effects (see MPEP 806.04 and MPEP 808.1). Groups I and II are in fact different and distinct inventions since Group I involves a method for reducing bandwidth by selectively sending media information over a communication network based on users' needs and capability, and Group II involves a method for reducing bandwidth in a communications network by displaying pre-stored image. And because the complete search for one group for example includes search areas not required for the other group, and vice versa, and thus causing a "serious burden" on the Office. Since the respective inventions are distinct for reasons given above, and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper. The requirement is therefore still maintained and is hereby made FINAL! Claims 75-79, 90-97 and 99 will now be examined, while claims 63-67, 69-71, 80-89 and 98 will be withdrawn from further consideration.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 75-79, 90-91, 93, 96 and 99 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U. S. Patent No. 7,003,040 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 75-79, 90-91, 93, 96 and 99 of the present application encompass claims 1-8 of the above US Patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 75-79, 90-91, 93, 96 and 99 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsu (US 5,907,604 (cited by the applicant).

Hsu discloses an image icon associated with caller ID comprising the same method for reducing bandwidth in a communications network, comprising:

pre-storing, in a receiving party called party terminal, a virtual image created by the receiving party (col. 2, ln. 18-21) based on at least one of the receiving party's prior knowledge of a calling party and the receiving party's his/her own perception of the calling party (caller ID); and

displaying the virtual image on the receiving party called party terminal when a call is received from a terminal of the calling party (col. 4, ln. 3-16) as specified in claim 75; determining an identity of the calling party when the call is received, and retrieving the pre-stored virtual image in response to the determined identity (col. 4, ln. 3-6) as specified in claim 76; wherein said determining is performed based on caller identification information associated with the call (col. 4, ln. 3-6) as specified in claim 77; wherein said displaying step further comprises displaying the virtual image on the receiving party terminal during an idle period when no media information is received from the calling party terminal (col. 4, ln. 38-41, only phone # is received, no media information is received within this ringing period) as specified in claim 78; wherein said displaying step includes: further comprises displaying the virtual image on the receiving party terminal during a period when only voice information is received from the calling

party terminal (col.4, ln. 17-20) as specified in claim 79; further comprising selecting at least one format for transmitting media information from the calling party terminal (col. 3, ln. 2-6 and col. 4, ln. 54-63) as specified in claim 90; wherein the selected at least one format for transmitting the media information comprises at least one of the following: (a) streaming video, (b) short-time video script, (c) a still image, and (d) a virtual image created by the calling party (col. 3, ln. 2-6 and col. 4, ln. 54-63) as specified in claim 91; wherein the receiving party selects the at least one format for transmitting the media information (col. 3, ln. 2-6 and col. 4, ln. 54-63: still image) as specified in claim 93; wherein the virtual image created by the calling party comprises an avatar (col. 2, ln. 5-13: fanciful or humorous images) as specified in claim 96; and wherein the calling party selects the at least one format for transmitting the media information (col. 3, ln. 2-6 and col. 4, ln. 54-63: at least still image) as specified in claim 99.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 92 and 97are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu.

As applied to claim 90 above, it is noted that Hsu does not particularly discloses wherein an identification of the selected at least one format for transmitting the media information is stored in association with calling party identification information, and

determined at the receiving party terminal as specified in claim 92; and wherein the identification is provided to the calling party and the receiving party as specified in claim 97. Since Hsu teaches many format for transferring data as conformed to ITU-T standards including H.320, H.323, H.324, and T.120 and in some instances, composite video information from external cameras and still camera images are wirelessly transferred. Therefore, it would have been obvious that any chosen format of the calling party for transmitting the media information to the receiving party (col. 2, ln. 16-18) must be agreed in advance by both parties or any new transferring format must be identified in association with the calling party to successfully communicate with the receiving party.

8. Claims 94-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu, in view of Lev et al (US 5,987,327).

As applied to claim 90 above, it is noted that Hsu does not particularly discloses wherein the calling party and the receiving party negotiate the selection of the at least one format for transmitting the media information as specified in claim 94; and wherein the calling party or the receiving party can unilaterally change the selected format for transmitting the media information as specified in claim 95. Lev et al teaches that "the ANS includes a negotiated information transfer rate and a communication path identifier. The negotiated information transfer rate reflects the minimum bandwidth requirements for the called party to complete the service. In the preferred embodiment, the negotiated information transfer rate will indicate a bandwidth requirement less than the full possible bandwidth when the call is a mobile-to-mobile call." (col. 6, ln. 4-32).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify the system of Hsu by allowing the negotiation between the calling party and the called party to ensure bandwidth allocation is proper for the transferring of media information and further more, the calling party would unilaterally decides on the minimum bandwidth requirement so as to complete the service.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Le (US 6,205,128 B1) discloses an enhanced handoff signaling for high speed data and multimedia.

b. Jones (US 6,307,836 B1) discloses a high-speed transparent access to multiple services.

c. Black (US 7,130,282 B2) discloses a communication device for providing multimedia in a group communication network.

d. Miki et al (US 2004/0029526 A1) discloses an image transmitting method, image transmitter, and memory product.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon T. Diep whose telephone number is 571-272-7328. The examiner can normally be reached on m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on 571-272-7418. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ND
7/15/2007

NHON DIEP
PRIMARY EXAMINER